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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,801	06/05/2001	Peter Simonelli	231.301	5916

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EXAMINER

YIP, WINNIE S

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SJK

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/874,801	SIMONELLI ET AL.	
	Examiner	Art Unit	
	Winnie Yip	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 December 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-40 is/are pending in the application.
  - 4a) Of the above claim(s) 8-13 and 19-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7, 14-18 and 24-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 03 December 2003 is: a) approved b) disapproved by the Examiner
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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## **DETAILED ACTION**

This office action is in response to applicant's amendment filed on December 3, 2002.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 3, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities: it failures to describe the new drawings figures 8-11 in the section of "Brief Description of the Drawings". Appropriate correction is required.

### ***Claim Objections***

3. Claims 29-36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Regard to these claims 29-37, the recited sub combination features "the portion of the building structure" (claim 29) and "the moisture barrier bars moisture penetration from .... the building structure" (claim 30), "the moisture exposed portion of the building structure" (claim 32), "the word board is placed in the portion of the building structure" (claim 33), and "the

building structure includes..." (claim 34) do not appear to consist with the limitation of the body of the claim because a building structure only functionally recited in the preamble for intended uses only. If applicant wants to claim a combination of a building structure including an exposed moisture portion and a dry portion and a floor system as claimed, all elements must be positively claimed. If not, the sub combination should be functionally recited as relative to those elements not positively claimed.

Due to the confusion, the claims 28-36 are being treated as a combination on the merits.

4. Claims 24, 37, 40 are also objected to because of the following informalities:

In claim 24, the term "the moisture and condensation barrier layer" (lines 6 and 7) should read "the moisture and condensation barrier".

In claim 37, it is not clear what does mean by "forming a barrier to moisture penetration from a portion of the wood board ..."? Should it read "forming a barrier to prevent moisture penetration from a portion of the wood board ..."?

In claim 40, it is not clear what does mean by "forming a barrier to moisture penetration into the wood board"? Should it read "forming a barrier to prevent moisture penetration into the wood board"?

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “a thickness sufficient to resist deterioration due to ... temperature or environmental conditions” causes the claims vague and indefinite because it would not be sufficient to state what the rating of the thickness is since the range of the environmental and temperature conditions may variously be changed.

***Claim Rejections - 35 USC § 102***

7. Claims 1, 4-6, 24-25, 27, 28-31, and 35-40 stand rejected under 35 U.S.C. 102(b) as being anticipated Nemeth '390.

Nemeth shows and teaches a flooring system comprising wood subfloors (26 or 41'), wood finished floors (17 or 27), a moisture and condensation barrier layer (28, 20, 30) made of a liquid rubberized coating material which is a plastic coating material such as thermoplastics (see col. 4, lines 47), said liquid plastic coating material (28, 20, 30) being applied to the wood subfloors (26) by an edge-coating device and being dried and cured thereafter (see col. 7, lines 13-14 and lines 38-43), wherein after the liquid plastic coating material (28, 20, 30) is cured into a solid after being coated onto selected portion such as on a bottom or sides of the wood subfloor, the barrier layer inherently has a thickness to form an elastomeric membrane for sufficiently preventing moisture and condensation from penetrating, and the coated subfloors is capably placed onto the concrete slab to form a wood subfloor with a moisture and condensation penetration protection.

8. Claims 24-25, 27, 28-29, 31-33, 35-37, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Padmanabhan et al. '942.

Padmanabhan shows and teaches a building construction material comprising wood boards (16), a moisture and condensation barrier comprising a liquid rubberized coating material such as polymeric substance (27) coated onto a lower side of the wood board, said liquid rubberized coating material (27) generally curing into a solid layer after being coated onto the wood boards, and the moisture and condensation barrier inherently having a thickness sufficient to prevent moisture and condensation from penetration due to exposure to a range environmental and temperature conditions.

In regard to claims 29, 31-37, Padmanabhan teaches the building construction material for use as a barrier to moisture penetration in a floor of the building structure such as a truck housing which inherently includes an interior space and exposed exterior portion, wherein the moisture barrier (27) prevents moisture penetration from the exterior moisture exposed portion of the building structure to interior dry portion of the building structure, and the coating material is coated at least one coated side of the wood board with the coated side facing the moisture exposed portion of the building structure.

9. Claims 24-25, 27-28, 30, 36, 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Radcliffe, et al. (US Patent No. 6,136,408).

Radcliffe et al. show and teach a building construction material comprising a wood board (10), a moisture barrier comprising a liquid rubberized coating material such as polymerized coating material (20) coated onto one surface of the wood board, said liquid rubberized coating

material (20) generally curing into a solid layer after being coated onto the wood boards, and inherently providing a thickness sufficient to prevent moisture penetrating (see col. 5, lines 22-38) that capably used as a portion of the word board to be exposed to moisture to a dry portion of a building structure under suitable temperature and environmental conditions.

10. Claims 1, 4-7, 14-15, 24-25, 27, 28-31, and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent No.195 20 567.

The German reference teaches a flooring system comprising a wood subfloor having a plurality of wood boards (1), wood finished floor (8) is placed over the wood subfloor, the wood board has a generally elongated cubicle shape with six sides which including four sides and upper and lower surfaces, a moisture and condensation barrier layer (5, 15) made of a liquid rubberized plastic coating material coated on either only four sides (see embodiment shown in Fig. 2) or all six sides (see embodiment shown in Fig. 4) of the wood boards, and the plastic coating material being cured and dried into a solid station after being coated onto the wood board to provide a prescribed thickness to form an elastomeric membrane for sufficiently preventing moisture and condensation from penetrating, and said coated wood boards (1) being placed on a backing or concrete slab(2).

***Claim Rejections - 35 USC § 103***

11. Claims 1-7, 14-18, 24-27, 28-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauran '651 in view of Abendroth et al. '936 and Nemeth '390.

Mauran show and teaches a flooring system comprising a wood subfloor having a plurality of wood boards (4) disposed on a concrete slab (6), a moisture and condensation barrier layer (5) disposed on the a lower surface of the wood boards, and the barrier inherently having a thickness for sufficiently preventing moisture and condensation from penetrating from the moisture exposed portion of the building structure to a dry interior portion of the building structure, and a radian heating system including pipes (7) supported by the concrete slab and disposed under the wood subfloors (4) and the moisture and condensation barrier layer (5).

Although Mauran does not define the flooring system further having a wood finished floor disposed on the wood subfloor, however, Abendroth et al. teach a flooring system, as a common practice, comprising wood finished floor secured on an upper surface of a wood subfloor supported on a concrete slab for providing a finished surface with selected appearance. It would have been obvious to one ordinary skill in the art at the time the invention made to modify the flooring system of Mauran provided a wood finished floor disposed on the wood subfloor as taught by Abendroth et al. as old and well known practice for providing a stronger flooring surface with desirable appearance for variety of applications. Further, Mauran and Abendroth et al. do not define the moisture and condensation barrier layer made of a liquid rubberized coating material to be coated onto the wood subfloor as claimed. Nemeth teaches a floor system comprising a moisture and condensation barrier layer (28) made of rubberized coating material which would be a liquid plastic coating material to be coated onto a wood board for provide a wood subfloor with moisture penetration protection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the flooring system of Mauran in view of Abendroth et al. having the moisture and condensation barrier layer being

made of rubberized coating material to be coated to preselected sides of the wood board of the wood subfloor as taught by Nemeth as an obvious methods of design choice for providing a moisture penetrating protection with reducing steps of installation as desired as to accommodate the specialized environmental and temperature conditions of the building structure.

In regard to claims 2 and 26, although Mauran does not define the moisture and condensation barrier layer having a particular thickness as claimed, Abendroth et al. further teach the flooring system comprising the moisture and condensation barrier layer having a thickness about 6 mil. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the moisture and condensation barrier layers of the flooring systems of Mauran having very dimensions of the thickness of as taught by Abendroth et al. as a matter of obvious design choice for providing with suitable thickness for sufficiently preventing moisture and condensation penetrating the barrier layer to accommodate the specialized environmental conditions.

#### *Response to Arguments*

12. Applicant's arguments filed December 3, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show the moisture and condensation barrier layer comprising "a liquid rubberized coating material" as claimed, it is not deemed persuasive. Nemeth and Padmanabhan teach a moisture barrier is made of plastic coating material to be applied on the wood board and cured to have a thickness for moisture protection. Although applicant argues, for example, Nemeth 's coating material are waxes or plastics which are chemically distinct from the rubberized material of Applicant such as

“Dynatron™ Dyna-Pro Rubberized Undercoat” as described in the specification, Applicant did not claim specify what type of liquid rubberized material. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In fact, each type of rubberized or polymerized coating material may have suitable chemically distinct from each other. The “liquid plastic coating material” is broadly read on the “liquid rubberized coating material” as claimed since “liquid plastic material” also includes rubberized or polymerized properties in the liquid station and also having higher tensile strength and elasticity properties

In response to applicant’s argument with respect to the claims rejected under 35 USC 103 (a) of that Mauran and Abendroth et al. do not teach or suggest a “moisture and condensation barrier” and “a liquid rubberized coating material” as suggested by the applicant’s invention, we agree that this is so, otherwise our rejection would have been entered under section U.S.C. 102 of the statute. However, applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Nemeth is used as a teaching reference to teach, as discussed set forth above, that a moisture barrier would be formed of a liquid plastic or rubberized coating material coated on the wood board instead of adhesively bonded on the wood board as to modify the flooring system of Mauran and Abendroth et al. to solve the same problem as defined by applicant.

Therefore, the rejection is deemed proper.

***Action Is Made Final***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
wsy  
February 21, 2003

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
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